UNITED STATES PATENT AND TRADEMARK OFFICE

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Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE _3_ MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.
- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
  Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

1)☒ Responsive to communication(s) filed on _26 February 2009_.

2a)☐ This action is **FINAL**.   2b)☒ This action is non-final.

3)☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

4)☒ Claim(s) _61-74_ is/are pending in the application.

     4a) Of the above claim(s) _65-69,71,72 and 74_ is/are withdrawn from consideration.

5)☐ Claim(s) _____ is/are allowed.

6)☒ Claim(s) _61-64, 70, and 73_ is/are rejected.

7)☐ Claim(s) _____ is/are objected to.

8)☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

9)☐ The specification is objected to by the Examiner.

10)☐ The drawing(s) filed on _____ is/are: a)☐ accepted or b)☐ objected to by the Examiner.

     Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).

     Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).

11)☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

12)☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).

     a)☒ All   b)☐ Some *   c)☐ None of:

         1.☒ Certified copies of the priority documents have been received.

         2.☐ Certified copies of the priority documents have been received in Application No. _____.

         3.☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

     * See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

1)☒ Notice of References Cited (PTO-892)

2)☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)

3)☒ Information Disclosure Statement(s) (PTO/SB/08)
     Paper No(s)/Mail Date _7/19/2005, 11/12/2008_.

4)☐ Interview Summary (PTO-413)
     Paper No(s)/Mail Date. _____ .

5)☐ Notice of Informal Patent Application

6)☐ Other: _____.

DETAILED ACTION

Acknowledgements

1.   The amendments filed 19 July 2005 and 12 November 2008 are acknowledged.

2.   Claims 61-73 are pending.

3.   Claims 61-64, 70, and 73 have been examined.

4.   This Office action is given Paper No. 20090420 for reference purposes only.

Examiner's Comments

5.   Applicant's claims employ language that does not serve to differentiate the

claims from the prior art.

6.   Claims 61, 70, and 73 recite that the request message is sent "…in a second or a

following transaction process out of the successive transaction processes *when* a

response message responding to the previously sent request message is normally

received from the server device…" Thus, sending a request message in a second or a

following transaction process is conditional on the response message responding to the

previously sent request message being normally received from the server device and is

not necessarily performed when the condition is not met. Further, claims 63 and 64

similarly recite conditional language that does not serve to differentiate the claims from

the prior art. Claims 63 recites "…wherein said update unit is configured to invert…*when*

said response receiving unit normally receives the response message." Claim 64 recites

"…send a request message, for a next transaction process…*in the* case where a

response message is normally received…" and "…send again a request message, for

the current transaction process…*in the case* where a response message is not normally

received..." MPEP §2106 II C states that language that suggests or makes optional but

does not require steps to be performed or does not limit a claim to a particular structure

does not limit the scope of a claim or claim limitation. Further, with regard to the method

claim, once the positively recited steps are satisfied, the method as a whole is satisfied -

- regardless of whether or not other steps are conditionally performed under certain

other hypothetical scenarios. (*In re Johnston*, 77 USPQ2d 1788 (CA FC 2006); *Intel*

Corp. v. Int'l Trade Comm'n, 20 USPQ2d 1161 (Fed. Cir. 1991); MPEP §2106 II C).

Claim Rejections - 35 USC § 101

7.   35 U.S.C. 101 reads as follows:

> Whoever invents or discovers any new and useful process, machine, manufacture, or composition of
> matter, or any new and useful improvement thereof, may obtain a patent therefor, subject to the
> conditions and requirements of this title.

8.   Claims 61-64, 70 and 73 are rejected under 35 U.S.C. 101 because the claimed

invention is directed to non-statutory subject matter.

9.   Claims 61-64 are directed to "a terminal device". Specifically, Claim 61 recites

that the terminal device includes "a holding unit" and "a sending unit". However, this is

merely software, and it has been held that software without a required computer-

readable medium-storing software that, when executed, causes the computer to perform

a particular process or method (MPEP 2106.01) is merely nonfunctional descriptive

material and non-statutory under 35 U.S.C. 101.

　　　　Claim 62-64 also rejected as each depends from claim 61.

10.   Based on Supreme Court precedent (See also *Diamond v. Diehr*, 450 U.S. 175,

184 (1981); *Parker v. Flook*, 437 U.S. 584, 588 n.9 (1978); *Gottschalk v. Benson*, 409

U.S. 63, 70 (1972); *Cochrane v. Deener*, 94 U.S. 780, 787-88 (1876)) and recent

Federal Circuit decisions, a §101 process must (1) be tied to another statutory class

(such as a particular apparatus) or (2) transform underlying subject matter (such as an

article or materials) to a different state or thing. In addition, the tie to a particular

apparatus, for example, cannot be mere extra-solution activity. See *In re Bilski*, 88

USPQ2d 1385 (Fed. Cir. 2008).

An example of a method claim that would not qualify as a statutory process

would be a claim that recited purely mental steps.

To meet prong (1), the method step should positively recite the other statutory

class (the thing or product) to which it is tied. This may be accomplished by having the

claim positively recite the machine that accomplishes the method steps. Alternatively or

to meet prong (2), the method step should positively recite identifying the material that is

being changed to a different state or positively recite the subject matter that is being

transformed.

In this particular case, claim 70 fails prong (1) because the "tie" (e.g. "for use in a

terminal device that obtains, from a serve device" and "received from the server

device") is representative of extra-solution activity as each step is not tied to the

particular apparatus that performs it. Additionally, the claim(s) fail prong (2) because

the method steps do not transform the underlying subject matter to a different state or

thing.

Claim 73 is also rejected as the computer program is not stored on a computer

readable medium (MPEP 2106.01).

Claim Rejections - 35 USC § 112

11.   The following is a quotation of the second paragraph of 35 U.S.C. 112:

> The specification shall conclude with one or more claims particularly pointing out and distinctly
> claiming the subject matter which the applicant regards as his invention.

12.   Claims 61-64, 70 and 73 rejected under 35 U.S.C. 112, second paragraph, as

being indefinite for failing to particularly point out and distinctly claim the subject matter

which applicant regards as the invention.

13.   Claims 61-64 make reference to multiple statutory classes of invention.

Specifically, claim 61 is directed towards "a terminal device". However, the claim recites

method steps such as "...sending of a request message, receiving of a response

message, and sending of a commit message..." A claim that purports to be within

multiple statutory classes is ambiguous and is properly rejected under U.S.C. 112,

second paragraph, for failing to particularly point out and distinctly claim the invention

(*Ex Parte Lyell*, 17 USPQ2d 1548 (B.P.A.I. 1990)).

        Claims 62-64 are also rejected as each depends on claim 61.

14.   The term "normally" in claims 60, 70, and 73 is a relative term which renders the

claim indefinite. The term "normally" is not defined by the claim, the specification does

not provide a standard for ascertaining the requisite degree, and one of ordinary skill in

the art would not be reasonably apprised of the scope of the invention. The use of the

term "normally" renders the reception of the response message unclear, as it is unclear

to one of ordinary how a message is "normally" received.

        Claims 62-64 are also rejected as each depends on claim 61.

15.   Claims 61, 70, and 73 recite sending "...in a second or a following transaction

process... a request message...when a response message responding to the

previously sent request message is normally received from the server device."

However, the claims do not require that a first request message be sent. Therefore, it is

unclear to one of ordinary skill in the art how a message can be sent in a second

transaction process after a response to a previously sent message is received, when

the claims do not recite that any request message is previously sent. An essential

purpose of patent examination is to fashion claims that are precise, clear, correct, and

unambiguous. Only in this way can uncertainties of claim scope be removed (*In re Zletz*,

13 USPQ2d 1320 (Fed. Cir. 1989)).

        Claims 62-64 are also rejected as each depends on claim 61.

Claim Rejections - 35 USC § 103

16.   The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all

obviousness rejections set forth in this Office action:

> (a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negatived by the manner in which the invention was made.

17.   Claims 61, 70, and 73 are rejected under 35 U.S.C. 103(a) as being

unpatentable over Fox (US Patent No. 5,875,291).

18.   Regarding claims 61, 70, and 73, Fox discloses a terminal device that obtains,

from a server device, information based on transaction processes, each of the

transaction processes including sending of a request message, receiving of a response

message, and sending of a commit message for finalizing completion of one

transaction, wherein the request message includes a transaction flag which

corresponds to a transaction currently being processed (Fox **4:33-5:5**), and said

terminal device includes:

- a holding unit which holds the transaction flag (Fox **4:46-49**);

- a sending unit configured to send, in a second or a following transaction process

  out of successive transaction processes, a request message including a

  transaction flag when a response message responding to the previously sent

  request message is normally received from the server device (Fox **4:35-40**; **4:46-**

  57), and to send a commit message in a last transaction process (Fox **4:67-5:5**).

Fox does not specifically disclose that the information requested by the terminal

device is for controlling the use of the information. Fox further does not specifically

disclose that the transaction flag has a value of 0 or 1 or that the value of the

transaction flag is an inverse of a transaction flag included in a previously sent request

message.

However, regarding limitations directed to the intended use of the information

requested by the terminal device and the intended use of the terminal device itself, they

do not serve to differentiate the claimed invention from the prior art. MPEP §2106 II C

states that language that suggests or makes optional but does not require steps to be

performed or does not limit a claim to a particular structure does not limit the scope of a

claim or claim limitation. An example of such language includes statements of intended

use or field of use (MPEP §2106 II C). Further, regarding the limitations directed

towards the value of the transaction flag, they do not serve to differentiate the claimed

invention from the prior art. These limitations describe data (the transaction flag) that is

stored or transmitted, and are thus directed towards nonfunctional descriptive material.

It has been held that where the printed matter is not functionally related to the substrate,

the printed matter will not distinguish the invention from the prior art in terms of

patentability …. [T]he critical question is whether there exists any new and unobvious

functional relationship between the printed matter and the substrate (*In re Gulack*, 217

USPQ 401 (Fed. Cir. 1983), *In re Ngai*, 70 USPQ2d (Fed. Cir. 2004), *In re Lowry*, 32

USPQ2d 1031 (Fed. Cir. 1994); MPEP 2106.01 II).

19.   Claims 62-64 are rejected under 35 U.S.C. 103(a) as being unpatentable over

Fox in view of Ishibashi, et al. (US Patent No. 5,613,065, hereinafter "Ishibashi").

20.   Regarding claim 62, Fox discloses a response receiving unit configured to

receive each response message sent from the server device in the transaction

processes (Fox **4:7-17**; **4:53-57**);

        Fox does not specifically disclose an update unit configured to update the

transaction flag held by said holding unit according to each reception result of said

response receiving unit.

        Ishibashi discloses storing a flag in an update unit and updating it according to each

reception result (Ishibashi **4:46-53**; **4:61-5:4**; **5:60-6:4**; **6:15-18**; **6:28-33**; **6:40-43**).

        Therefore, it would have been obvious to one of ordinary skill in the art at the time of

the invention to modify the system of Fox to include storing and updating a flag

according to each reception result in order for the receiving client to be able to independently check whether a message has been received without error (Ishibashi **4:46-53**; **4:61-5:4**).

21.   Regarding claim 63, Ishibashi further discloses that said update unit is configured to invert the value of the transaction flag held in said holding unit when said response receiving unit normally receives the response message (Ishibashi **6:19-34**).

22.   Regarding claim 64, Fox discloses that said sending unit is configured to send again a request message, for the current transaction process, including a transaction flag, in the case where a response message is not normally received by said response receiving unit (Fox **5:32-45**).

Fox does not specifically disclose that the sending unit sends a request message for a next transaction process in the case where a response message is normally received by said response receiving unit. Fox further does not specifically disclose that that transaction flag is either inverted or not inverted.

Regarding the limitation directed towards sending a request message for a next transaction process in the case where a response message is normally received, this does not serve to differentiate claimed invention from the prior because it is not necessarily performed. Sending a request message for a next transaction process is conditional on the response message being normally received, and thus it is not performed when the condition is not met. Accordingly, once the positively recited steps are satisfied, the method as a whole is satisfied -- regardless of whether or not other steps are conditionally performed under certain other hypothetical scenarios. (*In re*

Johnston, 77 USPQ2d 1788 (CA FC 2006); *Intel Corp. v. Int'l Trade Comm'n,* 20

USPQ2d 1161 (Fed. Cir. 1991); MPEP §2106 II C). Further, MPEP §2106 II C states

that language that suggests or makes optional but does not require steps to be

performed or does not limit a claim to a particular structure does not limit the scope of a

claim or claim limitation. Further, regarding the limitations directed towards the value of

the transaction flag, they do not serve to differentiate the claimed invention from the

prior art. These limitations describe data (the transaction flag) that is stored or

transmitted, and are thus directed towards nonfunctional descriptive material. It has

been held that where the printed matter is not functionally related to the substrate, the

printed matter will not distinguish the invention from the prior art in terms of patentability

.... [T]he critical question is whether there exists any new and unobvious functional

relationship between the printed matter and the substrate (*In re Gulack,* 217 USPQ 401

(Fed. Cir. 1983), *In re Ngai,* 70 USPQ2d (Fed. Cir. 2004), *In re Lowry,* 32 USPQ2d 1031

(Fed. Cir. 1994); MPEP 2106.01 II).

Conclusion

23.   The prior art made of record and not relied upon is considered pertinent to

applicant's disclosure.

- US Patent No. 5,920,705 to Lyon et al. for disclosing flags included in a
  message.

Any inquiry concerning this communication or earlier communications from the

examiner should be directed to Mohammad A. Nilforoush whose telephone number is

(571)270-5298. The examiner can normally be reached on Monday-Thursday 8 am - 5

pm.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's

supervisor, Calvin Hewitt can be reached on (571)272-6709. The fax phone number for

the organization where this application or proceeding is assigned is 571-273-8300.

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/M. A. N./
Examiner, Art Unit 3685

/Calvin L Hewitt II/
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